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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/986,186 12/05/97 PETERSON

T 8757-009

EXAMINER

HM12/0409

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NEW YORK NY 10036-2711

BRUSCA J

ART UNIT

PAPER NUMBER

1636

DATE MAILED:

04/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

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Commissioner of Patents

Please find below a communication from the EXAMINER in charge of this application.

Response to Amendment

1. The reply received on 3/10/99 is not fully responsive to the prior Office action mailed 12/2/98 because:

The Letter mailed 12/2/98 informed the Applicants that the Amendment received 10/15/98 cancelling all pending claims and entering new claims would not be entered because the new claims were drawn to a non elected invention and therefore the Amendment received 10/15/98 was non-responsive to the Office Action mailed 4/15/98. In parent Application No: 08/738944, a restriction requirement was set forth as repeated below:

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claim 1-21, 25, and 26, drawn to gene expression libraries and methods of making gene expression libraries, classified in class 536, subclass 23.1.
 - II. Claims 22-24, drawn to cosmid vectors, classified in class 435, subclass 320.1.

3. The inventions are distinct, each from the other because of the following reasons: Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the cosmid vectors could be used to clone a single selected gene and the libraries and their method of making could utilize vectors other than cosmids.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

The Applicants did not effectively traverse the restriction in parent Application No. 08/738944, and elected to prosecute Group 1, claims 1-21, 25, and 26. In the instant application, which is a continuation of parent Application No. 08/738944, a preliminary amendment cancelled claims 1-21, 25, and 26, leaving only claims 22-24 pending. An Office Action mailed 4/15/98 was sent rejecting claims 22-24 over prior art. The Applicants filed an amendment received 10/15/98 that cancelled all pending claims and attempted to enter new claims drawn to Group 1 of parent Application No. 08/738944. A letter was sent on 12/2/98 indicating that the Amendment received 10/15/99 was a non-responsive bona fide attempt to reply due to presentation of claims drawn to a non-elected invention. The Applicants were informed in the letter that the Amendment received 10/15/99 would not be entered. An Amendment was received 3/10/99 that did not address the content of the letter mailed 12/2/98, although it is apparent that the letter mailed 12/2/98 was received by the Applicants because an extension of time was received with the Amendment received 3/10/99 that

specifically mentions the letter of 12/2/98. The Amendment received 3/10/99 presents additional claims that depend from claims not entered in the Amendment received 10/15/98. As of the date of this letter, only claims 22-24 are pending in the instant application.

Originally presented claim 22 is drawn to a cosmid vector without a limitation that the vector comprises inserted nucleic acids derived from genomic libraries. Originally presented claims 23 and 24 are limited to cosmid vectors that do not contain inserted nucleic acids derived from genomic libraries. The Amendment received 10/15/98 contains claims drawn to genomic libraries without the limitation that the libraries comprise cosmid vectors. The Amendment received 3/10/99 contains claims drawn to genomic libraries comprising a cosmid vector. Because the Amendments received 10/15/98 and 3/10/99 contain claims drawn to genomic libraries with specific limitations as to the content of the genomic libraries instead of claims drawn to cosmid vectors, the Amendments received 10/15/98 and 3/10/99 are drawn to a non-elected invention and neither Amendment has been entered.

If the Applicants desire to prosecute the claims presented in the Amendments received on 10/15/98 and 3/10/99, they may file a CPA application based on the instant application and present an amendment cancelling claims 22-24, and presenting new claims drawn to any disclosed invention. The Amendments received 10/15/98 and 3/10/99 would not be entered upon filing of a CPA application based on the instant application.

Since the period for reply set forth in the Letter mailed 12/2/98 has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a). The period for reply began on 12/2/98, and a reply

to this Letter must be filed no later than 6/2/99 and be accompanied with an appropriate extension fee and petition for an extension of time.

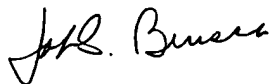
The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

4. Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. For routine submissions the FAX number is (703) 308-4242. For FAX transmissions in cases in which the Examiner has been notified by phone to expect the transmission, the FAX number is (703) 305-7939. In such cases please call the Examiner at (703) 308-4231 at the time of transmission to expedite delivery of the fax. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6 (d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday through Friday from 9 AM to 5

PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, Ph.D., can be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read "John S. Brusca". The signature is written in a cursive, flowing style.

John S. Brusca, Ph.D.

Patent Examiner